

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Appln. No.: 09/940,528

REMARKS

Claims 1-24 remain pending in the application. By this Amendment, new claims 16-24 are added.

Claims 1-4, 7, 8, 11, 12 and 15 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Shih et al. (U.S. Patent No. 6,674,923, hereinafter “Shih”). Claims 5 and 6 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Shih in view of Nelson et al. (U.S. Patent No. 6,431,448, hereinafter “Nelson”). Claims 9, 10, 13 and 14 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Shih in view of Bryniarski et al. (U.S. Patent No. 6,215,559, hereinafter “Bryniarski”). Applicant submits the following arguments in traversal of prior art rejections.

Applicant’s invention relates to a printing system and method which allows the formation of an image of high quality based on an image formed on an image recording medium. In an exemplary embodiment, such system includes, *inter alia*, an image server in which image data of an image formed on an image recording medium is stored; an image reading section for reading the image formed on the image recording medium; an image information reading section for reading, from the image recording medium, image information including information of the location of the image data; an image data reading section for reading the image data from the server corresponding to the image information read by the image information reading section; and an image reproduction section for forming the image based on image data read by the image reading section, or the image data read by the image data reading section.

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Rejection of Claims 1-4, 7, 8, 11, 12 and 15 under § 102(e) by Shih

Turning to the cited art, Shih relates to a method and system for locating and accessing digitally stored images. Shih discloses a digital storage device for storing digital images, an access device for accessing the digital image storage device, a hard copy print having printed thereon an address which is used by the access device to access the digital image from the digital storage device and a printer for printing such digital image.

The Examiner contends that Shih teaches each feature of independent claim 1. Applicant submits the rejection is not supported.

Claim 1 recites, *inter alia*,

an image reading section for reading the image formed on the image recording medium;

an image information reading section for reading, from the image recording medium, image information including information for specifying the image server and a position at which the image data is stored in the image server;

...

an image reproduction section for forming, on another image recording medium which is different from the image recording medium, the image formed on the image recording medium based on one of image data, read by the image reading section, of the image or the image data read by the image data reading section.

First, Shih does not teach or disclose an image reading section and an image information reading section. The Examiner cites col. 4, lines 36-39 of Shih as inherently disclosing a scanner for image reading which supposedly corresponds to the claimed image reading section for reading the image formed on the image recording medium and the reading device 105 as teaching an image information reading section. The cited sections, reproduced here for the Examiner's convenience, discloses that “[w]hile it is known that the image 36 can be scanned from the original print 35, the

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information obtained from scanning would not be as good as the digital image record file obtained from the original scanned images, for example on the film[.]” Assuming *arguendo*, that the reading device 105 corresponds to the claimed image information reading section and that the scanning of the image 36 from the original hard copy print 36 inherently discloses a scanner which corresponds to the claimed image reading section, Shih does not teach or disclose having a scanner when there is already a reading device 105. Rather, Shih discloses the drawbacks of scanning the hard copy print 35 and using the scanned information to generate additional hard copies. *See* col. 4, lines 36-41. To have better copies, Shih teaches away from scanning the hard copy print 35 and, instead, teaches having the reading device 105 to read a *code* on the hard copy print 10 to access an image storage site where images are stored. *See* col. 4, lines 47-49; and col. 8, lines 49-57.

Second, Shih does not disclose or teach an image reproduction section for forming, on another image recording medium which is different from the image recording medium, the image formed on the image recording medium based on one of image data, read by the image reading section, of the image or the image data read by the image data reading section, as recited in claim 1. The Examiner cites photofinishing section 62 as disclosing an image reproduction section. Photofinishing section 62, however, does not have the capability to print from the image data corresponding to the image read by the image reading section which reads the image formed on the image recording medium.

Claim 1 is patentable at least for the above reasons.

Claims 2-4, 7, 8 are patentable at least by virtue of their dependency.

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Claims 11, 12 and 15 contain analogous features recited by claim 1 and are patentable at least for the reasons submitted for claim 1.

Applicant also adds new claims 16-24 to more particularly describe the invention.

Rejection of Claims 5 and 6 under 35 U.S.C. § 103(a) by Shih in view of Nelson

Claims 5 and 6, which depend from claim 1, are patentable for at least the deficiencies of Shih submitted for claim 1 and the failure of Nelson to make up for the deficiencies of Shih.

Rejection of Claims 9, 10, 13 and 14 under 35 U.S.C. § 103(a) by Shih in view of Bryniarski

Claims 9, 10, 13 and 14, which either depend from claim 1 or contain analogous features recited by claim 1, are patentable for at least the deficiencies of Shih submitted for claim 1 and the failure of Bryniarski to make up for the deficiencies of Shih.

New claims 16-24, which depend from claim 1 or 11, are patentable for at least the reasons submitted for claim 1 or 11.

In addition, claims 23 and 24 are patentable for the recitations therein. For example, Shih does not teach, suggest or provide motivation for all elements of claim 23. In an embodiment of the invention, an image and image information are read and inputted to a memory 30. Shih, however, merely discloses that only a bar code (image information) is read at a kiosk 98 by a reading device 105.

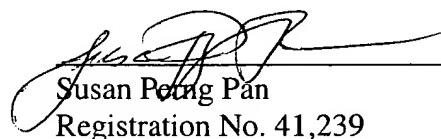
Also, for claim 24, none of the cited references teach, suggest or provide motivation for an encoding section which converts a URL information indicating a position at which the image data is stored. In an embodiment of the present invention, the information converted by the encode section 72 is outputted to a printer processor 18 for printing.

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In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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